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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,194	06/25/2003	Mark J. Radcliffe	MS1-1547US	5791
22971 7590 07/09/2008 MICROSOFT CORPORATION ONE MICROSOFT WAY REDMOND, WA 98052-6399				
EXAMINER				
MOSSER, KATHLEEN MICHELLE				
ART UNIT		PAPER NUMBER		
3714				
NOTIFICATION DATE		DELIVERY MODE		
07/09/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

roks@microsoft.com  
ntovar@microsoft.com

### Office Action Summary

**Application No.**

10/607,194

**Applicant(s)**

RADCLIFFE ET AL.

**Examiner**

Kathleen Mosser

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03/17/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 32-41 and 43-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 32-41 and 43-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-108)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

In response to the amendment filed 08/21/2007; claims 1-8, 32-41 and 43-48 are pending.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 38-41 and 43-45 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The preamble of the claims recites "an apparatus for providing audio and lyrical data to a user", however the components of the claims are not drawn to structural components. In claim 38, each of the components (an audio player, a language selection module, a lyric display module, and a lyric editor) are disclosed as being software modules or programs. Similarly, claim 43 recites each of these components in means plus function language. As the means are not clearly identified in the specification, the examiner has interpreted that they are embodied in the same software modules presented in claim 38. As such, the claims are drawn to a computer program or software *per se* and are thus drawn to non-statutory subject matter.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. Claims 1-8, 32-41 and 43-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover et al (US 5469370) in view of Qian et al (US 2002/0193895) further in view of Lakritz (US 6623529). Ostrover teaches a method for providing audio and lyrical data to a user including: receiving a user request to play an audio file (col. 2: 38-41); identifying based on the user request, a preferred language for displaying lyrics (col. 3: 16-20); identifying an alternative language from for the lyrics if the preferred language is not available (col. 25: 21-32) and playing the audio data and the lyrics with either the preferred or the alternative lyrics, as needed (see Figures 5A, 5B and 5D), as in claims 1, 8, 32, 37, 38, and 45-47. It is noted that process of selecting an alternative language is not automated within the Ostrover process. It has been held that the automation of an otherwise manual practice, when the automation of such a process is within the ordinary skill in the art, is an obvious modification and does not render a claim patentable over the prior art. The process of having a computer system automatically determine an alternative language is akin to having a system switch to a default presentation language when a selected language is not available. The programming required for such a selection process is well within the ordinary skill in the art and thus the automation of the manual process of Ostrover et al is considered prima facie obvious. Ostrover teaches that the use of English if lyric data is not available in the preferred or alternate language (claims 33), see the description of the default language in col. 3: 8-14 and col. 23: 9-13. The lyric sets, including the alternate lyrics, being stored separate from the audio file (claims 3 and 41) in at least col. 22: 34-56.

Ostrover does not teach that the selection of the alternate language/sublanguage (dialect) is selected by searching a "hierarchical list" of language priorities (claims 1, 7, 8, 32, 37, 38, 43, and 46).

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Lakritz teaches a procedure for procuring information over a network which automatically identifies a preferred language/dialect and, when the data is not available in the preferred language attempts to retrieve the next closest based upon a sorted list, see col. 5: 60 - col. 6: 2). It would have been obvious to one of ordinary skill in the art to include the prioritized list of related languages, as taught by Lakritz, in implementing the invention of Ostrover so as to automatically determine the closest language to present to the user when a preferred or optimal language is unavailable (the benefit taught by Lakritz).

Ostrover does not teach the inclusion of a lyric editor that allows a user to add lyrics to an audio file and edit existing lyrics (claims 32 and 37). Ostrover et al does not explicitly refer to the use of time-codes to be associated with the displaying of lyrical segments (claims 4-6, 36, 39) or that the lyric data is stored with the audio file (claims 2, 34, 40, 45, and 48). The invention of Qian et al is designed to allow a user to edit and create lyric files to be associated with multimedia content (see Figure 18 and its associated description). Qian et al mentions the use of timestamps in paragraph 7 and details the creation of such throughout the specification. It would have been obvious to one of ordinary skill in the art to include the functionality of the Qian et al invention into the Ostrover et al invention so as to allow the user to edit and create their captioned multimedia files.

With respect to claim 35, neither Ostrover, Qian nor Lakritz explicitly teaches receiving a request to change the language while playing back the audio file (though Lakritz does mention receiving a request for content in a different language), and repeating the steps of determining if the language is available, and displaying such. The examiner however, takes OFFICIAL NOTICE that it is well-known in the art of multi-media playback to allow a user to change their original selection. For example, and with reference to the Ostrover patent specifically, a user watching a motion picture may decide to switch the language options for the sub-titles, such is commonly available through a menu screen on traditional DVD players. It would have been obvious to one of ordinary skill in the art to allow the user to redefine the language in which to view the lyric data (subtitles) during play back of an audio file, and further to repeat the steps of determining if a requested language was available, so as to allow the user greater flexibility and customization during the presentation of the audio data.

***Response to Arguments***

3. Applicant's amendments to claims 8 and 37 are sufficient to overcome the previous objection to the claims. Applicant's amendments to claims 1, 8, 35 and 46 are sufficient to overcome the previous rejections under 35 USC §112, second paragraph.

4. Applicant's arguments filed 03/17/2008 have been fully considered but they are not persuasive.

**Rejections under 35 USC §101**

Applicant asserts that claims 38-41 and 43-45 are directed statutory subject matter as the specification discloses a general purpose computer which may be used to implement the components of these claims. However, the specification makes no requirement that this general purpose computer environment must be the structural components recited in the claims. On the contrary the specification clearly recites that this environment is to be non-limiting (page 17 line 24 – page 18 line 2 of the specification as originally filed). Further, the components of the claims, particularly those of claim 38, are listed as separate elements of this structure. The "media player" is listed as an application that may be executed by the computer, clearly meeting the definition of a computer program. Further on page 22, lines 3-14, the specification defines the "modules" as routines, programs, and objects which may be executed in a computer. This clearly shows a separation of the computer and the program code portions that may be executed therein. As such the broadest reasonable interpretation of the claims, as understood from the specification, renders the claims to read on a computer program per se, and as such rejection of the claims as being drawn to non-statutory subject matter is proper.

**Remaining arguments**

Applicant's remaining arguments with respect to Ostrover and Qian et al are moot in view of the new grounds of rejection. In view of this new grounds of rejection, this action is made non-final.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Mosser whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kathleen Mosser/  
Primary Examiner, Art Unit 3714

July 2, 2008